

**Exhibits**

UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

E. & J. GALLO WINERY,	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No. 91155195
	)	
CERVECERIA CENTROAMERICANA, S.A.	)	
(Central American Brewery, Inc.)	)	
	)	
Applicant.	)	
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**OPPOSER'S MEMORANDUM OF POINTS AND AUTHORITIES IN  
RESPONSE TO APPLICANT'S MOTION FOR PARTIAL SUMMARY JUDGMENT**

Applicant asks the Board to decide as a matter of law, and on the basis of a single *DuPont* factor (similarity), that there can *never* be confusion between Opposer's famous GALLO mark and Applicant's GALLITO mark. This extraordinary motion is almost totally devoid of probative evidence: no discovery responses, no affidavits, and no testimony. Applicant's motion must be denied because there is no proper basis for the Board to grant it.

**I. BACKGROUND.**

Opposer, E. & J. Gallo Winery, owns a family of trademarks containing the term GALLO. *E. & J. Gallo Winery v. Gallo Cattle Co.*, 12 U.S.P.Q. 2d 1657, 1659 (E.D. Cal. 1989), *affirmed*, 967 F.2d 1280 (9<sup>th</sup> Cir. 1992). The GALLO mark has been used by Opposer on wine for nearly 70 years. *Id.* at 1660. It has also been used on salame, *id.* at 1661, and on other goods.

(Declaration of Gerry Glasgow, ¶3) (“Glasgow Decl.”). The GALLO mark has been held to be “an extraordinarily strong and distinctive mark,” *id.* at 1667; strong enough to qualify for dilution protection under anti-dilution statutes, *id.* at 1668-1669; *E. & J. Gallo Winery v. Spider Webs Ltd.*, 129 F.Supp.2d 1033, 1038-1039 (S.D. Tex. 2001), *affirmed*, 286 F.3d 270 (5<sup>th</sup> Cir. 2002); *E. & J. Gallo Winery v. Pasatiempos Gallo, S.A.*, 905 F.Supp. 1403, 1411 (E.D. Cal. 1994); *E. & J. Gallo Winery v. Consorzio del Gallo Nero*, 782 F.Supp. 457, 469 (N.D. Cal. 1991).

Applicant is a brewery in Guatemala. (Declaration of Paul W. Reidl, ¶3) (“Reidl Decl.”) It seeks to register the trademark GALLITO in Class 32 for beers and waters. (*Id.* ¶4). Applicant previously applied to register the trademark GALLO for beer. (*Id.* ¶6). This was abandoned after the Examiner refused registration based on Opposer’s GALLO mark. (*Id.*).

This Opposition was initiated on December 21, 2002. It was based on both confusion and dilution grounds. (Opposition, ¶¶11-13). In its Answer, Applicant asserted the following Affirmative Defense:

*Opposer is estopped from arguing its alleged GALLO mark is similar to that of Applicant’s GALLITO mark by virtue of Opposer’s prior representations and admissions that GALLO is a surname and represents the family name of certain individuals associated with Opposer.*

(Answer, p. 3).

In a letter of May 2, 2003, Opposer demanded that Applicant strike this defense because it had no legal basis. (Reidl Decl., Exh. 4). Applicant disagreed, stating that estoppel defenses were permitted by the Board’s rules. (*Id.*, Exh. 5). Opposer thereupon suggested that it would stipulate to the “factual” basis for this defense so that Applicant could file a dispositive motion on it. (*Id.*, Exh. 6). The Parties then agreed to the following stipulation:

*It is stipulated by Opposer herein that Gallo is the surname of the founders of E. & J. Gallo Winery. It is further stipulated that Opposer continues to be owned by the Gallo family.*

(Applicant's Memorandum, Exh. A) ("App. Mem.").

Applicant's motion only addresses the likelihood of confusion claim. (App. Mem., p. 11-13). It does not address Opposer's dilution claim.

The Parties agreed to ask the Board to stay further discovery pending the Board's disposition of this motion. In this manner, the Parties could avoid the expense of discovery if the Board agreed that summary judgment for either party was appropriate.

Opposer's Memorandum is accompanied by: (a) Opposer's Statement of Facts, (b) Declaration of Gerry Glasgow, and (c) Declaration of Paul W. Reidl.

## **II. THE STANDARD FOR GRANTING SUMMARY JUDGMENT.**

Summary judgment is appropriate where, based on the evidence, "there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242 (1986). The burden of proof and persuasion rests with the movant. *Copeland's Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 1565 (Fed. Cir. 1991). The moving party's motion must be supported by evidence sufficient to show there is no genuine issue of material fact and that it is entitled to judgment as a matter of law. If the movant makes this showing, then and only then does the burden shift to the non-moving party to proffer evidence sufficient to establish the existence of a genuine factual dispute. *Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 940 (Fed. Cir. 1990). All of the facts must be viewed in the light most favorable to the non-moving party, which must also receive all inferences and all reasonable doubt. *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 767 (Fed. Cir. 1993).

**III. APPLICANT HAS NOT SUBMITTED SUFFICIENT EVIDENCE ON WHICH THE BOARD CAN GRANT SUMMARY JUDGMENT ON THE MERITS.**

In order to prevail on this motion, Applicant must set forth *evidence* to establish that there is no factual basis under the factors set forth in *E. I. DuPont De Nemours & Co.* (“DuPont”), 476 F.2d 1357 (CCPA 1973), on which the Board could find a likelihood of confusion between GALLO and GALLITO. Applicant has not met that burden.

Applicant’s motion does not contain a Statement of Material Facts Not Genuinely In Dispute so it is difficult to identify all the facts Applicant considers to be material and not in dispute. Applicant’s motion is accompanied, however, by six exhibits:

- the Stipulation (App. Mem. Ex. A).
- an excerpt from a response to an Office Action (*Id.*, Ex. B).
- excerpts from dictionaries (*Id.*, Ex. C).
- a handbook of pronunciation (*Id.*, Ex. D).
- excerpts from a Spanish dictionary and web site (*Id.*, Ex. E).
- printouts from TESS (*Id.*, Ex. F).

These exhibits purport to establish Applicant’s entitlement to judgment under the *DuPont* factors. However, Applicant’s memorandum also sets forth numerous additional “facts” on which its argument is based. These additional “facts” are merely naked assertions of counsel and are wholly unsupported by evidence:

- Applicant’s GALLITO mark does not create a commercial impression similar to Opposer’s GALLO mark (*Id.*, p. 5, ¶7).

- The only commercial impression made by Opposer's GALLO mark is that it denotes a refined style of living, especially as concerns dining and associated joys of life (*Id.*, p. 5, ¶7).
- Opposer's and Applicant's respective goods are derived from different sources (*Id.*, p. 8, ¶15).
- Opposer's and Applicant's goods are made and produced differently (*Id.*, p. 8, ¶15).
- Opposer's and Applicant's goods are sold or marketed in different ways (*Id.*, p. 8, ¶15; p. 13, line 21).
- Opposer's and Applicant's goods are different and unrelated (*Id.*, p. 8, ¶15).
- GALLITO has meaning only in Spanish (*Id.*, p. 12, line 10).
- Opposer has never pursued an enforcement action against a GALLITO mark (*Id.*, p. 12, line 12).

In addition to these assertions, Applicant does not even mention most of the other *DuPont* factors, such as the sophistication of purchasers and the fame of the GALLO trademark. Nor does Applicant discuss whether the marks are similar in appearance.

This incomplete record does not discharge Applicant's burden of demonstrating *through evidence* that it is entitled to judgment as a matter of law, nor is it sufficient to shift to Opposer the burden of proffering evidence sufficient to establish a genuine issue of material fact. It is plainly not a sufficient record for the Board to determine that there is no likelihood of confusion as a matter of law.

**IV. THE MARKS ARE SIMILAR ENOUGH TO PRECLUDE GRANTING SUMMARY JUDGMENT IN FAVOR OF APPLICANT.**

Applicant correctly states that the standard for determining likely confusion emanated from *DuPont*. That decision made it clear that while one factor may play a “dominant role,” all of the relevant factors must be considered by the Board. *DuPont*, 476 F.2d at 1362. In this motion, however, Applicant claims that similarity of the marks is the dominant – indeed exclusive – factor for determining likelihood of confusion. It argues that summary judgment should be granted because the trademarks GALLO and GALLITO are so dissimilar that there is no likelihood of confusion as a matter of law. (App. Mem. at 11). This argument is based on an elaborate series of assertions, assumptions and inferences, including Applicant’s estoppel claim.

It is, of course, theoretically possible for marks to be so dissimilar that the Board could conclude, on the basis of lack of similarity alone, that there is no likely confusion as a matter of law even though all of the other *DuPont* factors favored Opposer. An example might be ZZGYZWY TZ vs. BRD. Those are not similar by any stretch of the imagination. But that is not the case for GALLO vs. GALLITO – which are similar on their face – and Applicant cites no case where summary judgment has ever been granted based solely on a consideration of this single *DuPont* factor.<sup>1</sup>

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<sup>1</sup> The cases cited by Applicant are inapposite. *In re Buchner Enterprises Corp.*, 6 U.S.P.Q.2d 1316 (TTAB 1987), was an *ex parte* “foreign equivalents” case involving very dissimilar marks, PALOMA and DOVE, yet the Board still considered the nature of the goods and the channels of trade. *In re Storck KJ*, 218 U.S.P.Q. 823 (TTAB 1983), was also an *ex parte* proceeding and again the Board considered the nature of the goods and the channels of trade. *Fisher Radio Corp. v. Bird Electronic Corp.*, 162 U.S.P.Q. 265 (TTAB 1969), was decided by the Board after a trial, not on summary judgment. At issue were a design mark and a composite design/word mark. This case predates *DuPont*.

Determining the similarity of trademarks requires an examination of their sight, sound and meaning. Similarity of any one of these factors may be sufficient to support a finding of likely confusion. *In re Lamson Oil Co.*, 6 U.S.P.Q.2d 1041 (TTAB 1987); *see Interstate Brands Corp. v. McKee Foods Corp.*, 53 U.S.P.Q.2d 1910 (TTAB 2000); *In re White Swan, Ltd.*, 8 U.S.P.Q.2d 1534 (TTAB 1988). Applicant's motion must be denied because it has failed to adduce evidence sufficient to shift the burden of going forward to Opposer.

**A. The Marks are Similar in Appearance.**

Applicant does not even discuss the similarity in the appearance of the two marks: GALLO and GALLITO. The marks are very similar in appearance because the first four letters and the last letter of the marks are identical. (Glasgow Decl., ¶6). This omission alone speaks volumes about the weakness of Applicant's motion, for marks having this degree of similarity have readily been found to be sufficiently similar to support a finding of likely confusion. *See, e.g., Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1492 (Fed. Cir. 1987) (COMMCASH and COMMUNICASH were similar.); *Jockey Int'l Inc. v. Mallory & Church Corp.*, 1992 TTAB LEXIS 53 (ELANCE and ELAAN were similar). Since any one factor could establish similarity and the non-movant must be given the benefit of the doubt on a summary judgment motion, this omission alone is sufficient grounds to deny Applicant's motion.

**B. The Marks are Similar in Sound.**

Applicant cites a pronunciation guide for the "correct" English language pronunciation of GALLO, and a Spanish language dictionary for the "correct" Spanish language pronunciation of GALLITO. (App. Mem. at p. 4, ¶4; p. 6, ¶11). On this basis, Applicant concludes that the marks are dissimilar in sound. (*Id.*, p. 12).

This proves nothing.

It is axiomatic that there is no "correct" pronunciation of a trademark. *E. & J. Gallo Winery v. Pasatiempos Gallo, S.A.*, 905 F.Supp. 1408, 1409 (E.D. Cal. 1994); *In re Lamson Oil Co.*, 6 U.S.P.Q.2d 1041 (TTAB 1987). The only relevant pronunciation is the pronunciation that will be given to the mark by consumers in the United States, not the "correct" Spanish pronunciation or the "correct" English pronunciation. *J. B. Williams Co. v. Le Conte Cosmetics, Inc.*, 523 F.2d 187, 192 (9<sup>th</sup> Cir. 1975), *cert. denied*, 424 U.S. 913 (1976); *Pfizer, Inc. v. Cody John Cosmetics, Inc.*, 211 U.S.P.Q. 64, 68-69 (TTAB 1981); *E. I. DuPont de Nemours & Co. v. Societe Anonyme Francaise dite: BIG CHIEF*, 189 U.S.P.Q. 358, 359 (TTAB 1976). Applicant has submitted no evidence on how consumers might be expected to pronounce the marks and, therefore, the burden to demonstrate a genuine issue of material fact does not shift to Opposer. Applicant's motion should be denied on this basis.

The situation in this case is the same as in *E. & J. Gallo Winery v. Pasatiempos Gallo, S.A.*, 905 F.Supp. 1408 (E.D. Cal. 1994). The Defendant in that case was selling Mexican games and playing cards, allegedly targeted at Spanish-speaking consumers. It argued that because the Spanish pronunciation of its GALLO mark was GUY-OH, consumers could distinguish it from plaintiff's GAL-OH mark. The court dismissed the argument:

*At retail outlets, however, consumers confront visual, not audible, stimuli created by the parties' marks. There is no way for consumers to know that the parties intend the marks to be pronounced differently. In fact, nothing on parties' products prevents consumers from pronouncing plaintiff's GALLO mark as GUY-OH, and defendant's GALLO mark as GAL-OH.*

905 F.Supp. at 1409, 1412.

The Court's conclusion is confirmed by the undisputed record. In the experience of one marketing expert, it is almost a certainty that the "GALL" portion of Applicant's mark will be pronounced by English-speaking people as it is with Opposer's mark. (Glasgow Decl., ¶7). And



if the consumer speaks only Spanish, they are likely to pronounce both marks in the Spanish manner as is done in Latin America. (*Id.*). In either case, there is no “correct” pronunciation of the marks; the evidence shows they will be pronounced similarly by some consumers.

**C. The Marks are Similar in Meaning.**

Applicant devotes considerable time to arguing that Opposer is estopped from arguing that “Gallo” means “rooster” in Spanish and Italian, from arguing that it is anything but a surname, and from arguing that it means anything other than something having to do with Gaul or the French lifestyle. (App. Mem. at p. 3, ¶¶3, 4).

Applicant’s arguments are again irrelevant. The test is not what a trademark means in the abstract, but what it means to consumers in context. *See TBC Corporation v. Holsa, Inc.*, 126 F.3d 1470, 1472 (Fed. Cir. 1997) (rejecting reliance on dictionary definition as “of little or no weight” and applying contextual analysis). Applicant’s argument that GALLITO will be given its *Spanish-language* dictionary meaning by consumers in the United States is fallacious because GALLITO is not an English language term. Based on this record, the Board can only speculate about how *English* speaking people will learn of the *Spanish* meaning. As this Board observed in a case involving a Spanish language term:

*But, who would be aware of this [Spanish] meaning? There is no question but that some segment of purchasers conversant in Spanish-American dialects may be aware of this significance if they would take the time and effort at the point of purchase to make this analysis. However, the concept or understanding of the general or ordinary purchaser of the goods involved, not that of linguistic experts or specialists or those few, percentage wise, familiar with a foreign language, as to the meaning of a word trademark is the controlling factor in determining the question of likelihood of confusion.*

*Jules Berman & Associates, Inc. v. Consolidated Distilled Products, Inc.*, 202 U.S.P.Q. 67, 70 (TTAB 1979). Given the absence of relevant evidence on this point, the burden of coming

forward with evidence to establish a genuine issue of material fact does not shift to Opposer. Moreover, Applicant's own evidence shows that "Gallito" itself may have multiple meanings in Spanish, including "little rooster." (App. Mem., Exh. F).

As for the GALLO trademark, its dictionary meaning is equally irrelevant. This is a trademark that is well known to consumers and has been in use for nearly 70 years. It is "an extraordinarily strong and distinctive mark...[whose] evolution to 'secondary meaning' status may not be seriously questioned." *E. & J. Gallo Winery v. Consorzio del Gallo Nero*, 782 F.Supp. 457, 462 (N.D.Cal. 1991). Whether "Gallo" is a surname, has a dictionary meaning having something to do with Gaul, or means "rooster" (which is the preferred definition of Applicant's President) (Reidl Decl., ¶7), is no longer especially germane to the analysis.

Faced with the absence of relevant evidence and multiple dictionary meanings of the marks, Applicant resorts to a bit of sophistry. It argues that the "meaning" of Gallo has been conclusively established as being "something relating to Gaul and perhaps specifically to France." (App. Mem., Exh. B). This statement was made by a German company during the prosecution of an application to register GALLO, and (according to Applicant), Opposer is estopped from denying it because Opposer now owns the registration. Since none of the dictionary meanings of "GALLITO" is "Gaul or France," Applicant concludes that the two marks are therefore dissimilar as a matter of law. (App. Mem. at 11-12). Applicant is, at bottom, inviting the Board to apply the patent law doctrine of file wrapper estoppel to the Lanham Act.

The Board is not compelled to conclude that consumers understand the house mark of California's largest winery to mean "France." This conclusion would be factually (Glasgow Decl., ¶5) and legally absurd. This Board has repeatedly rejected invitations to apply file wrapper estoppel in its proceedings, holding instead that statements made during the prosecution

of an application are merely evidence to be weighed by the trier of fact. *EZ Loader Boat Trailers, Inc. v. Cox Trailers, Inc.*, 213 U.S.P.Q. 597, 599 (TTAB 1982), *affirmed*, 706 F.2d 1213 (Fed. Cir. 1983); *see Bost Bakery, Inc. v. Roland Industries, Inc.*, 216 U.S.P.Q. 799, 802 (TTAB 1982); *Dynamark Corp. v. Weed Eaters, Inc.*, 207 U.S.P.Q. 1026, 1028 (TTAB 1980).<sup>2</sup> This is entirely consistent with Federal Court decisions. In *Polo Fashions, Inc. v. Extra Special Products, Inc.*, 451 F.Supp. 555 (S.D.N.Y. 1978), for example, the defendant argued that statements made during the prosecution of the application to register the famous POLO trademark estopped the trademark owner from arguing that the mark should be broadly construed. The court deemed the argument "specious":

*Statements made during an ex parte prosecution before the United States Patent and Trademark Office seeking registration do not circumscribe for all time the rights the registrant may acquire thereafter through extensive use.*

451 F.Supp. at 561. *Accord, Keebler Co. v. Rovira Biscuit Corp.*, 624 F.2d 366, 373 n. 7 (1<sup>st</sup> Cir. 1980); *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 929 n. 2 (CCPA 1978); *Universal Motor Oils Co. v. Amoco Oil Co.*, 15 U.S.P.Q.2d 1613, *modified*, 743 F.Supp. 1484 (D. Kan. 1990) (conclusion of law 38).

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<sup>2</sup> File wrapper estoppel makes sense in patent law because the scope of a patent holder's rights is defined by the patent claims. Thus, an applicant's statement about the scope of the claims made during the prosecution process is so highly probative of the meaning of the claims that it is frequently given an estoppel effect. By contrast, the scope of a trademark owner's rights is defined by external, marketplace factors that have nothing to do with the prosecution of the application. Accordingly, a statement made during the prosecution of a trademark application does not have an estoppel effect. It is merely one piece of evidence to be considered by the trier of fact. The case relied on by Applicant, *Kay Corp. v. Westfield's, Inc.*, 190 U.S.P.Q. 565 (TTAB 1976), predates the authority cited in this Memorandum.

The statement that "Gallo" means "Gaul" or "France" to consumers should be given no weight at all.<sup>3</sup> Opposer has in its applications consistently represented that the term "Gallo" means "rooster" in Italian and Spanish (Reidl Decl., ¶11; *see* Glasgow Decl., ¶4). Applicant's President has stated that GALLO means "rooster" in Spanish (Reidl Decl., ¶7), and Applicant again made this representation in a recently-filed application (Reidl Decl., ¶14).<sup>4</sup> Since Applicant's own evidence shows that one meaning of GALLITO is "little rooster" (App. Mem., Exh. F), it is likely that at least some Spanish-speaking consumers will give the marks the same meaning.

**V. THE SIMILARITY OF THE MARKS MAY NOT BE EXAMINED OUT OF CONTEXT; THE CONTEXT COMPELS DENIAL OF APPLICANT'S MOTION.**

Applicant's desire to focus solely on similarity is not supported by the cases cited in its Memorandum. Each of those cases, in some form, looked at similarity in its marketplace context. *See n. 1 supra*. That is required by *DuPont*. This makes a great deal of sense because the ultimate standard for the Board is "likelihood of confusion," a standard that demands examination of the marks in their marketplace context and not in the abstract. In this case, the Board has the benefit of a substantial body of jurisprudence on Opposer's mark and on the other *DuPont* factors, such as similarity of the parties' goods and the channels of trade. When these

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<sup>3</sup> The statement relied on by Applicant was made by the lawyer for a German applicant who applied to register a GALLO trademark in Classes 8, 11, 16, 20, 21, 24 and 34. The Examiner was not entirely persuaded by the argument because registration was allowed only on the Supplemental Register. Opposer acquired the mark and associated goodwill in settlement of a lawsuit in 1992. (Reidl Decl., ¶12). To the extent this statement is given any weight at all, it should only affect claims unique to that registration.

<sup>4</sup> Applicant owns a pending application to register the trademark ROOSTER for beer, SN 76/328,179. The application is based in part on a Guatemalan application to register the same mark. The Guatemalan application, which was filed with the USPTO, states that the Spanish translation of the term "ROOSTER" is GALLO. In light of this filing, Applicant's contention in this case that GALLO means something other than "ROOSTER" in Spanish is, at best, disingenuous and, at worst, sanctionable under Rule 11. (Reidl Decl., ¶14).

are considered, and the benefit of the doubt is given to Opposer, Applicant's motion must be denied.

First, and foremost, is the substantial body of jurisprudence on Opposer's mark. Unlike marks that exist merely as abstractions on the Principal Register, Opposer's mark has been used for nearly 70 years, is highly promoted, and is indisputably famous with a high degree of consumer recognition. (Glasgow Decl., ¶¶3, 5). *See cases at pp.1-2 supra*. It has been litigated successfully four times in cases involving cheese, wine, Mexican games and playing cards, and a domain name. In light of the jurisprudence, the facts about Opposer's GALLO mark cannot be seriously disputed. As a well-known mark, Opposer's GALLO mark is entitled to the broadest scope of protection, and the fame factor – not the similarity factor – plays a *dominant* role in the *DuPont* analysis. *See, e.g., Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.3d 350, 352 (Fed. Cir.), *cert. denied*, 506 U.S. 862 (1992); *Time Warner Entertainment Co. v. Jones*, 2002 TTAB LEXIS 462 (TTAB 2002). These cases teach that famous marks enjoy a broad scope of protection, and that “as a mark's fame increases, the [Lanham Act's] tolerance for similarities in competing marks falls.” *Kenner Parker Toys, supra*, at 353.

There is also a substantial body of case law on the similarity of goods factor. Applicant's assertions notwithstanding, wine and beer are similar goods as a matter of law. They are both fermented alcohol beverages. (Glasgow Decl., ¶9). *In re Sailerbrau Franz Sailer*, 23 U.S.P.Q.2d 1719 (TTAB 1992) (citing cases) (refusing registration of CHRISTOPHER COLUMBUS for beer in light of CRISTOBAL COLON for wine).<sup>5</sup> This Board has held that:

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<sup>5</sup> Applicant argues, without citation to authority, that Opposer's failure to prevent the registration of GALLITO for certain goods is “conclusive” proof that Opposer's claims are baseless. (App. Mem. at 7-8, ¶¶ 13-14). The simple response is that none of these registrations were for goods that are similar to Applicant's goods, *i.e.*, alcoholic and non-alcoholic beverages.

“[A]s the degree of similarity of the goods of the parties increases, the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines.” *Fossil, Inc. v. Fossil Group*, 49 U.S.P.Q.2d 1451 (TTAB 1998) (citing *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 877 (Fed. Cir. 1992)).

The goods – beer, wine, waters – also share the same channels of trade. They are sold by the same distributors to the same kinds of customers in the same retail outlets. (Glasgow Decl., ¶8). *In re Sailerbrau Franz Sailer*, 23 U.S.P.Q.2d 1719 (TTAB 1992); see *Specialty Brands v. Coffee Bean Distrib.*, 748 F.2d 669, 672 (Fed. Cir. 1984). This enhances the likelihood of confusion because it means that the same consumers are more likely to be exposed to the marks in close temporal and spatial proximity.

Wine and beer have also been held to be impulse purchases, which enhances the likelihood of confusion. *E. & J. Gallo Winery v. Consorzio del Gallo Nero*, 782 F.Supp. 457, 464-465 (N.D. Cal. 1991) (wine) (citing cases); *In re Sailerbrau Franz Sailer*, 23 U.S.P.Q.2d 1719 (TTAB 1992) (beer). Bottled waters also fall into that category. *Sprinklets Water Center, Inc. v. McKesson Corp.*, 806 F.Supp. 656, 659 (E.D.MI 1992); (Glasgow Decl., ¶10).


Finally, Opposer’s GALLO mark is also clearly its house mark and is used in a variety of ways on a variety of goods. See cases at pp.1-2 *supra*. (Glasgow Decl., ¶3). Applicant’s mark is not yet in use. (Reidl Decl., ¶9). There is, therefore, no possibility of developing evidence of co-existence without actual confusion, nor is there any possibility of a laches defense. And Opposer’s aggressive trademark enforcement program has “preserved the effectively exclusive connection in consumer awareness between Gallo and wine.” *E. & J. Gallo Winery v. Gallo Cattle Co.*, 12 U.S.P.Q.2d 1657, 1667 (E.D.Cal. 1989), *affirmed*, 967 F.2d 1280 (9<sup>th</sup> Cir. 1992); (Reidl Decl., ¶13).

At bottom, at least five of the *DuPont* factors strongly favor Opposer in this case: GALLO is a famous mark, it is Opposer's house mark, the goods are impulse items, the goods are similar, and the goods are sold in the same channels of trade. The remaining factors are, at worst, neutral. Applicant's motion offers no contrary evidence or case law. Based on this record, it would plainly be erroneous to conclude as a matter of law that there is no likely confusion between GALLO and GALLITO.

**VI. CONCLUSION**

Applicant's motion fails to establish a *prima facie* entitlement to summary judgment in this case, so Opposer has no burden of rebuttal. But when all of the *DuPont* factors and disputed facts are considered, it is clear that summary judgment for the Applicant would be inappropriate on this record. If anything, summary judgment should be granted *sua sponte* in favor of Opposer. TBMP § 528.08. The marks have strong similarities, and the other *DuPont* factors strongly favor Opposer and are well supported by precedent.

Respectfully submitted,



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Dated: June 12, 2003

**E. & J. GALLO WINERY**

**Paul W. Reidl**  
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June 12, 2003

**VIA EXPRESS MAIL**

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06-12-2003  
U.S. Patent & TMO/TM Mail Rpt Dt. #22

**Re: E. & J. Gallo Winery  
Trademark GALLITO (SN 76/380,736)  
Opposition No. 91155195**

Dear Sirs:

Enclosed are the original and one copy of the documents described as follows:

- Opposer's Memorandum of Points and Authorities in Response to Applicant's Motion for Partial Summary Judgment
- Opposer's Statement of Facts
- Declaration of Gerry Glasgow
- Declaration of Paul W. Reidl

Thank you in advance for your prompt attention to this matter.

Very truly yours,

Paul W. Reidl

EF 276203905 US

Date of Deposit: June 12, 2003

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office To Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner of Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.

Name:

P.O. Box 1130, 600 Yosemite Boulevard, Modesto, California, 95353  
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